REMARKS

Claims 14 and 16-50 are presently pending in the application. Reconsideration and allowance of all claims are respectfully requested in view of the following remarks.

As a preliminary matter, the Applicant notes that the Examiner has not yet acknowledged receipt of six (6) sheets of Corrected Formal Drawings, which were filed in the application on March 8, 2005. The Applicant requests that the Examiner acknowledge receipt of the Corrected Formal Drawings.

Turning to the Office Action of April 26, 2005, the Examiner has allowed Claims 14 and 16-25.

However, the Examiner has rejected Claims 26-50 under 35 U.S.C. § 112, ¶ 2, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims have been amended to delete "applicable" regulatory standards, in favor of the definite terminology of --predetermined-- regulatory standards. Accordingly, the rejection of Claims 26-50 should now be obviated.

Claims 26, 29, 32, 33, 34, 35, 40, 41, 43 were finally rejected by the Examiner under 35 U.S.C. 103(a) as being unpatentable over Husain et al. (US 6,361,695) in view of Tyllila (US 6,638,420) and Wipperman (US 6,672,233). Further, Claims 27, 28, 30, 31, 41, 44-46 were finally rejected under 35 U.S.C. 103(a) as being unpatentable over Husain in view of Tyllila and Wipperman as applied to claim 26 above, and further in view of Tompkins et al. (US 5,932,091). For the following reasons, the prior art rejections are respectfully traversed.

The Applicant respectfully submits that neither Husain et al., Tyllila, nor Wipperman, either alone or in combination, teaches or suggests a wastewater ballast method including the

steps of: collecting wastewater generated during operation of a vessel; filtering the wastewater; treating the filtered wastewater to meet predetermined regulatory standards; storing the treated wastewater in a wastewater ballast tank; transferring the treated wastewater to a discharge unit; and discharging the treated wastewater from the vessel, as recited in amended Claim 26, and as substantially recited in amended Claims 44 and 50.

Rather, Husain et al. are silent with respect to treating the wastewater after the filtering step, to meet predetermined regulatory standards. Further, the bioreactor 30 in Husain et al. does not treat the wastewater – rather, it simply allows the untreated wastewater to be oxygenated. No "treatment" of wastewater is conducted in Husain et al.

However, in the present invention, the wastewater is treated by decontamination methods, such as by applying electromagnetic radiation, after the filtering step.

Further, there is no motivation to combine Tyllila with Husain et al., since Tyllila is directed to non-analogous art of sewage plants, and not that of handling shipboard wastewater.

Further, even if combined, Tyllila does not teach or suggest treating filtered wastewater to meet predetermined regulatory standards. In fact, Tyllila is silent with respect to a filtering step, and providing air into the aeration chambers 1, 2 is not considered "treating" the wastewater to predetermined regulatory standards, as is done in the present invention.

Further, neither Husain et al. nor Tyllila disclose using a wastewater ballast tank to store the treated wastewater. The Examiner alleges that Wipperman discloses this feature. However, the Examiner is using impermissible hindsight in using Tyllila and Wipperman to provide the features that Husain et al. lacks.

For example, there is no motivation to use a wastewater ballast tank in the Husain et al. device, since that invention is complete in itself. Replacing any of the tanks with a wastewater ballast tank would change the operation of Husain et al. completely, and not result in the claimed features of the present invention. The same holds for Tyllila, which is directed to sewage plants. Therefore, there is no motivation to combine a wastewater ballast tank from Wipperman with that of the Tyllila device.

The Examiner is reminded that the fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). Further, although a prior art device "may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the references to do so." 916 F.2d at 682, 16 USPQ2d at 1432. A statement that modifications of the prior art to meet the claimed invention would have been "well within the ordinary skill of the art at the time the claimed invention was made" because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references. *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993). See also *In re Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1318 (Fed. Cir. 2000). See MPEP 2143.01.

Accordingly, Claims 26, 44, and 50 are not obvious over either the individual or the combination of the Husain et al., Tyllila, and Wipperman references, and the rejection of Claims 26, 44, and 50 under 35 U.S.C. §103 should be withdrawn.

With respect to Claims 28 and 45, none of the applied prior art references teaches or suggests a turbidity monitor to measure turbidity of the treated wastewater. The applied prior art references are silent with respect to this feature. Thus, Claims 28 and 45 are patentable.

With respect to Claims 37-39 and 47-49, none of the applied prior art references teaches or suggests using a second disinfection unit to disinfect the treated wastewater from the wastewater ballast tank. Thus, Claims 37-39 and 47-49 are patentable.

Further, since Claims 27-43 depend from Claim 26, and Claims 45-49 depend from Claim 44, they are also patentable over the applied prior art for the reasons cited above with respect to Claims 26 and 44.

If the Examiner believes that there is any issue which could be resolved by a telephone or personal interview, the Examiner is respectfully requested to contact the undersigned attorney at the telephone number listed below.

Applicants hereby petition for any extension of time which may be required to maintain the pendency of this case, and any required fee for such an extension is to be charged to Deposit Account No. 04-1061.

DICKINSON WRIGHT PLLC
1901 L St., N.W.
Suite 800
Washington, D.C. 20036
Telephone: 202/659-6946
Facsimile: 202/659-1559
Date: **July 26, 2005**

Respectfully submitted,

Jean C. Edwards
Registration No. 41,728

DC 71048-168 1025R3v1

Certificate of Transmission Under 37 CFR 1.8

I hereby certify that this correspondence is being facsimile transmitted to the U.S. Patent and Trademark Office (571) 273-8300 on July 26, 2005.

Pamela Cei